

From: E. Nishibori JPAA
Sent: Thursday, October 04, 2012 2:05 AM
To: fitf_rules
Cc: 山川 茂樹 先生; 花田 茜; 鈴木 孝章 先生
Subject: JPAA Comments on Proposed Rules

Dear Hon. David Kappos,

Please find the attached document.

Sincerely yours,
Emi NISHIBORI

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October 4, 2012

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Alexandria, Virginia

Re: JPAA Comments on the “Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act”

Dear Under Secretary Kappos:

The Japan Patent Attorneys Association (JPAA) is a professional association of more than 9,600 patent attorneys practicing in intellectual property laws in Japan. Its members practice in all areas of intellectual property laws including copyright and unfair competition. Many are capable of representing clients before infringement courts. The JPAA would like to submit comments on the “Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act”.

The following is the Comments of the proposed amendments to Title 37 of the Code of Federal Regulations.

●Section 1.9 is proposed to be amendment to add the definition of the terms.

Comment : In 37 U.S.C. 1.9, it is reasonable to add the definition of the terms that have been used in 35 U.S.C.

●Section 1.55 is proposed to be amendment to require that the claim for priority and a certified copy of the foreign provision be file in certain condition with respect to



amended 35 U.S.C. 102 and 103.

Comment : The JPAA is worried that the proposed Section 1.55, that requires the claim to a claimed invention having an effective filing date after March 16, 2013 as well as the claim for priority of the foreign application, could cause complications for the application prosecution. Therefore, the JPAA wishes that the USPTO should reduce applicant's efforts for providing materials corresponding to the requirements of the proposed Section 1.55.

Furthermore, the proposed Section 1.55 requires that the applicant's statements for a subject matter in the nonprovisional application that is not disclosed in the foreign application. However, with respect to the difficulty of identifying the subject matter, the JPAA wishes that, in the proposed Section 1.55, the USPTO should relax the requirement of the application's statement for the subject matter that is not disclosed in the foreign application.

● Section 1.78 is proposed to be amended to require that the claim for benefit of a prior-filed provisional application, a prior-filed nonprovisional application, and international application.

Comment: The JPAA is worried that the proposed Section 1.78, that requires the claim to the benefit of a prior-filed provisional application, a prior-filed nonprovisional application, and international application, could cause complications for the application prosecution. Therefore, the JPAA wishes that the USPTO should reduce applicant's efforts for providing materials corresponding to the requirements of the proposed Section 1.78.

● Section 1.109 is proposed to be added to specify the effective filing date of a claimed invention. Section 1.110 is proposed to provide the information concerning the inventorship and ownership of the subject matter of each claimed invention.

Comment: The JPAA considers that providing the information for specifying effective filing date, and inventorship and ownership of the subject matter of each claimed invention are reasonable.

● Section 1.130 is proposed to provide an affidavit and declaration to establish that a disclosure is not prior art. Section 1.131 is proposed to be amended to cover the



provision of current Section 1.130.

Comment: The JPAA considers that an amended Section 1.130 and Section 1.131 may be amended to manage the New Grace Period system that shows the disclosure on which the rejection is based is not prior art, when the disclosure is based on the public disclosure or subject matter published by the inventor or joint inventor.

However, The JPAA wishes that in case of showing of the conception of the invention with due diligence in Section 1.131(b), the USPTO should provide an appropriate example.

Sincerely yours,

A handwritten signature in black ink, which appears to read "Shoichi Okuyama". The signature is fluid and cursive, written over a light blue horizontal line.

Shoichi Okuyama

President

Japan Patent Attorneys Association